

Applicant: Philip KRAFT

Response to Office Action mailed: December 31, 2008

Response Filed: January 27, 2009

**REMARKS**

United States Serial No. 10/589,654 is a national stage application of International Application No. PCT/CH2005/000137, filed March 7, 2005, which claims the benefit of GB 0405723.8, filed March 15, 2004. The date of entry into the national stage of United States Serial No. 10589,654 is August 16, 2006. A preliminary amendment was also filed on August 16, 2006 upon entering the national stage. The 371(c) date (date of date of receipt of the 35 U.S.C. §371(c)(1), (c)(2) and (c)(4) requirements and date of completion of all 35 U.S.C. §371 requirements) is April 13, 2007.

Claims 1-15 are currently pending. An Office Action mailed December 31, 2008 has subjected claims 1-15 to a unity of invention requirement and has required Applicant to make an election of species. Applicant has made the necessary elections in response to the unity of invention and election of species requirements, discussed in detail below. In view of the traversing arguments set forth herein, Applicant respectfully requests that alleged Groups I and II within claims 1-15 be rejoined and allowed.

**RESPONSE TO LACK OF UNITY OF INVENTION REQUIREMENT**

In the Office Action mailed December 31, 2008, the Examiner required Applicant to elect one of the following Groups based on the unity of invention standard:

Group I (claims 1-15): drawn to compounds and methods in which the furan ring contains no double bonds.

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Group II (claims 1-15): drawn to compounds and methods in which the furan ring contains a double bond.

The Office Action of December 31, 2008, also set forth an election of species requirement alleging that the application contains claims directed to the following patentably distinct species allegedly set forth in claims 2, 8, and 13-15:

- (I) 2-*tert*-butyl-5-methyl-2-propyl-2,5-dihydrofuran
- (II) 2-*tert*-butyl-5-methyl-2-propyltetrahydrofuran
- (III) 2-*tert*-butyl-2-isopropyl-5-methyl-2,5-dihydrofuran
- (IV) 2-*tert*-butyl-2-isopropyl-5-methyltetrahydrofuran
- (V) 2-*tert*-butyl-2-ethyl-5-methyl-2,5-dihydrofuran
- (VI) 2-*tert*-butyl-2-ethyl-5-methyltetrahydrofuran
- (VII) 2-*tert*-butyl-2,5-dimethyl-2,5-dimethyl-2,5-dihydrofuran
- (VIII) 2-*tert*-butyl-2,5-dimethyltetrahydrofuran
- (IX) 2-(3',3'-dimethylcyclohexyl)-2,5-dimethyl-2,5-dihydrofuran
- (X) 2-(3',3'-dimethylcyclohexyl)-2,5-dimethyltetrahydrofuran

Consequently, Applicant has also been required to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is

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held allowable. In this regard, page 3 of the Office Action states that all claims are generic.

In response to the unity of invention requirement, Applicant elects to prosecute the claims of Group II, drawn to compounds and methods in which the furan ring contains a double bond, (claims 1-15) and traverse the restriction for the reasons set forth below. In response to the election of species requirement, Applicant elects the species comprising (I) *2-tert-butyl-5-methyl-2-propyl-2,5-dihydrofuran*, for the compound, composition, and methods claimed in claims 1-15.

The Office Action alleges that the claims of Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features over the prior art in view of the reference marked "X" in the PCT Search Report. Applicant respectfully traverses.

In regard to the unity of invention requirement between the claims of Groups I and II, it is respectfully submitted that a prior art search of compounds and methods in which the furan ring contains no double bonds would inherently include compounds and methods in which the furan ring contains double bonds. According to MPEP 1850 under heading "III. B. Markush Practice", "When the Markush grouping is for alternatives of chemical compounds, they shall be regarded as being of similar nature where the following criteria are fulfilled: (A) All alternatives have a common property or activity;

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and (B) (1) A common structure is present, i.e., a significant structural element is shared by all of the alternatives; or (2) In cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains."

In this case, all the alternative compound of formula (I) share a common property or activity of being fragrances. In addition, the alternative compounds of formula (I) share a common chemical structure of the furan ring, the only difference being that the furan ring containing a double bond designates the delocalization of an electron pair in the furan ring. Furthermore, even if the common furan structure of formula (I) cannot be the unifying criteria, all the alternative compounds defined by formula (I) belong to a recognized class of chemical compounds in which an oxygen atom is part of a five ring cyclical structure comprising 4 carbon atoms. Consequently, the difference between these two types of furan rings is so slight that it is hard to imagine that a prior art search can be conducted of furan rings containing double bonds while at the same time excluding furan rings containing no double bonds and vice versa. In fact, separate prior art searches of compounds within Groups I and II would require the Office to review the same references in order to separate and distinguish references which disclose a furan ring comprising a double bond from those in which a furan ring comprises no double bond. Finally, "the fact that the alternatives of a Markush grouping can be differently classified should not, taken alone, be considered to be justification of a finding of a lack of unity of invention." See MPEP 1850 III. B. "Markush Practice".

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Furthermore, Applicant respectfully submits that the Office Action has not adequately identified the reasons why unity of invention allegedly does not exist in the present case. PCT Rules 68.1 and 68.2 requires an Examiner in making a lack of unity of invention requirement during a preliminary international examination, to specify the reasons why the international application is considered as not complying with the requirement of unity of invention. This standard also applies to the examination of the unity invention requirement during the national stage according to Article 2 of the Agreement between the United States Patent and Trademark Office (USPTO) and the International Bureau of the World Intellectual Property Organization in relation to the functioning of the USPTO as an International Searching Authority and International Preliminary Examining Authority under the Patent Cooperation Treaty. According to MPEP 1893.03(d), "When making a lack of unity of invention requirement, the examiner must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group." Furthermore, according to MPEP 1850, "Whether or not any particular technical feature makes a "contribution" over the prior art, and therefore constitutes a "special technical feature," should be considered with respect to novelty and inventive step." Form paragraph 18.07.02 (MPEP 1850) provides the language necessary for making a unity of invention requirement when the shared technical feature allegedly does not make a contribution over the prior art. In the present case, Applicant respectfully submits that the Office Action fails to adequately identify the technical feature shared by the groups, and allege how the shared technical

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feature lacks novelty or inventive step in view of the reference(s) in accordance with MPEP 1850.

In addition, Applicant respectfully requests confirmation that the cited art reference (identified as reference X in the PCT Search Report) for which the alleged special technical feature of the present claims fails to make a contribution over is P.Goldfinger: "Reactions of Halogen Atoms" Pure & Applied Chemistry, vol. 5, 1962, pages 423-440, as the Office Action fails to identify the disclosure in the reference upon which its determination was made.

As set forth above, the Office Action not only fails to make a proper allegation for lack of unity of invention, but searching the alleged two groups would pose no additional search burden on the Office. In view of the above remarks, Applicant respectfully requests a withdrawal of the unity of invention requirement between Groups I and Group II, and request the issuance of a formal notice of allowance directed to claims 1-15.

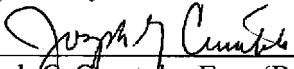
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Should the Examiner have any questions about the above remarks, the undersigned attorney would welcome a telephone call.

Respectfully submitted,

  
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